REMARKS

This application pertains to a novel hotmelt pressure sensitive adhesive, which is characterized by a low shrinkback after extrusion coating.

Claims 1 - 5 and 7-29 are pending.

Claims 10-15 and 18-29 have been withdrawn from consideration as drawn to a non-elected invention, so that the claims under examination are claims 1-5, 7-9 and 16-17.

Applicants note with appreciation that the non-elected subject matter will be rejoined with the elected subject-matter upon allowance of elected subject-matter, and repeat their request for said rejoinder (Office Action of 05/24/2005).

Claims 1, 3-9, 16 and 17 stand rejected under 35 USC 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al (US 6,472,025).

Applicants have previously pointed out, in their response of March 29, 2005, that Massow's polyacrylate is a very specific copolymer of an acrylate monomer with N-tert.-butylacrylamide; whereas Guldbrandsen is specific to low molecular weight acrylate hotmelts. Applicants also pointed out that Guldbrandsen does not single-out chalk as being any different than any other filler, or as having any special advantages when combined with any special polyacrylate.

Applicants further pointed out that they have discovered and, by their examples, demonstrate **unexpected results** for hotmelt pressure-sensitive adhesives meeting the parameters of Claim 1. More specifically, Applicants have made the surprising and unexpected discovery that the addition of calcium carbonate to their specific hot-melt pressure sensitive adhesive produces an unforeseen improvement in the shrinkback properties of the adhesive. This is demonstrated by Applicants' Examples, as shown by the data of Table 1, found on page 20. In this regard, it should be noted that the only difference between reference examples 1 and 2 and inventive examples 3 and 4 is the presence or absence of the chalk.

To this, the Examiner responds that he has a reasonable basis to believe that the addition of fillers to a matrix resin would improve shrinkback properties of the claimed adhesive and that in his opinion Applicants unexpected results are "expected". The Examiner's position is, of course, based on sheer speculation and he has not produced one shred of evidence to support his speculative conclusions. The Examiner has not pointed to anything that would teach or suggest that the addition of fillers to an acrylate based hotmelt pressures sensitive adhesive would reduce shrinkback. The Examiner's *speculation* cannot rebut Applicants' showing of unexpected results.

Moreover, the Examiner overlooks the claim limitation that the pressure-sensitive adhesive composition must be substantially free of carboxyl or hydroxyl groups. The Massow reference teaches that monomers which contain carboxyl groups are ***preferred*** (col. 4, line 18), as are those having hydroxyl groups (col 4, line 20). Massow therefore

teaches away from Applicants' novel pressure sensitive adhesive composition.

Accordingly, no combination of Massow and Guldbrandsen could possibly lead to Applicants' novel low-shrinkback pressure-sensitive adhesive, and the rejection of claims 1, 3-9, 16 and 17 under 35 USC 103(a) as unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al (US 6,472,025) should now be withdrawn.

Claim 2 stands rejected under 35 USC 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al (US 6,472,025) and in further view of Lai (US Pub. 2003/0120101 A1).

The Examiner relies on Lai for a molecular weight of less than 500,000. The copolymer of Lai is, however, a completely different polymer than that of Massow or Guldbrandsen, and the Examiner has not shown why anyone would want to make the polymers of Massow or Guldbrandsen in the molecular weight range of e.g. 600 – 3500 disclosed by Lai. The Examiner has not shown anything in any of the references that would suggest this. More specifically, the Examiner has not shown any ***motivation*** for his proposed combination of references.

Even if, however, any product that could be derived from the Massow/ Guldbrandsen combination of references were to be made in the molecular weight range disclosed by Lai, Applicants' demonstration of unexpected advantages, as discussed above, would not be overcome.

Accordingly, claim 2 cannot be seen as obvious over Massow and Guldbrandsen in further view of Lai, and the rejection of claim 2 under 35 U.S.C.103(a) as obvious over Massow et al (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (U.S. Pub. 2003/0120101) should now be withdrawn.

In view of the present remarks it is believed that claims 1-5 and 7-29 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS, McLAUGHLIN & MARCUS, PA

By _____
William C. Gerstenzang
Reg. No. 27,552

WCG/zs
875 Third Avenue - 18th Floor
New York, New York 10022
(212) 808-0700

I hereby certify that this correspondence is being transmitted via facsimile, no. 571-273-8300 to the United States Patent and Trademark Office, addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 10, 2006.

By _____
Zsuzsa Schuster
Date January 10, 2006